

**REMARKS**

This Response is submitted in response to an outstanding Non-final Office Action dated August 5, 2008 (the "Office Action"). The shortened statutory period for response expires on November 5, 2008; therefore, this Response is timely submitted and does not require payment of extension fees.

I. Status of the Claims

Claims 1-35 are pending in the application with claims 21, 26, and 31 in independent form. Applicant previously canceled claims 1-20, hereby cancels claims 25, 30, and 35, and hereby amends claims 21, 26, and 31.

II. Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 21-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0161603 A1 to Gonzales ("Gonzales"), and further in view of U.S. Pat. No. 6,126,202 A to Scocca ("Scocca"), U.S. Pat. No. 6,210,172 B2 to Clements ("Clements"), and U.S. Pat. No. 5,127,879 A to Schubert ("Schubert"). In addition, the Examiner rejected claim 31 as being unpatentable over Gonzales, Scocca, Clements, Schubert, and U.S. Pat. No. 5,397,156 A to Schach et al. ("Schach").

Applicant respectfully traverses the Examiner's rejections.

A. Gonzales, Scocca, Clements, Schubert, and Schach

In addition to the more detailed reference-by-reference discussion below, Applicant respectfully asserts that the all references cited by the Examiner at least do not disclose

*automatically generating a cover page* for printing on a first leaf's front-side from the *first set of inputs*, wherein the cover page includes at least one of title information, author information, and one or more images; ...

*automatically generating a title page* for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and a copyright notice information; ...

*automatically generating a first story page* from the one or more images *from the second set of inputs* for printing on the second leaf's back-side and automatically proportionally enlarging the one or more images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page; and ...

*automatically generating a second story page from the second set of inputs* for printing on a third leaf's front-side including the one or more images and the corresponding text, wherein the one or more images and corresponding text, when printed, appear oriented in diametric contraposition to the one or more images on the first story page,

as stated in currently amended independent claims 21, 26, and 31. The cited references operate in a "what you see is what you get" ("WYSIWYG") manner. That is, what the user sees and inputs, is what the software outputs on a page-edit-by-page-edit basis. On the contrary, in aspects of the present disclosure, the user inputs minimal information in two "*blank story book screens*" which results in "*automatically generating*" at least "a cover page," "a title page" (that is printed on a first leaf's back-side and a second leaf's front-side), "a first story page," and "a second story page" "*for printing in diametric contraposition*". In addition, the data that the user inputs is presented in different ways depending on the page (e.g., some pages have just the image proportionally enlarged, while other pages have the image and certain text). Accordingly, these

references alone, or in combination, do not disclose or teach the limitations stated in independent claims 21, 26, and 31 and/or the claims that depend therefrom.

B. Gonzales

First, the Examiner stated that “Gonzales teaches a storytelling book and method of providing a storytelling book (interactive publishing system, Para. 0032; method, Para. 0043-44).” Office Action at p.3, para. 5. Gonzales Para. 0032 discloses: “The present invention relates to an interactive publishing system capable of supporting multiple lines of business (LOBs). Although the system may be employed for the publishing of hard copy material, such as a brochure or magazine, it is described herein in the context of a web site, where the term ‘publish’ means to post material to the site, i.e., to ‘go-live’ on the site.” Gonzales Para. 0043 discloses: “Memory 135 holds data and instructions for execution by processor 130. In particular, memory 135 contains a program module that controls processor 130 to perform a method in accordance with the present invention as described herein. The program module is also known as a content management application.” Gonzales Para. 0044 discloses:

Although system 100 is described herein as having the instructions for the method of the present invention installed into memory 135, the instructions can reside on an external storage media 140 for subsequent loading into memory 135. Storage media 140 can be any conventional storage media, including, but not limited to, a floppy disk, a compact disk, a magnetic tape, a read only memory, or an optical storage media. Storage media 140 could also be a random access memory, or other type of electronic storage, located on a remote storage system and coupled to memory 140.

Accordingly, Gonzales merely discloses *a* system and *a* method, but in no way teaches or discloses “a *storytelling book* and method of providing *a storytelling book*,” as described in independent claims 21 and 26.

Second, in the Office Action, the Examiner stated Gonzales teaches “(a) accepting a first set of inputs from a user in a first graphical user interface screen and providing them to the

software program (an Author can create an article, etc., Para. 0068-78).” Office Action at p.3, para. 5. Gonzales paras. 0068-78, in short, discloses:

An Author can create an article, add content to the article, edit the article and delete the article.... [T]he Author can establish or define new content, edit the content and delete the content....The Author can create a new article. A new article is a page, such as a web page, of information about a topic. The Author can edit an article that is returned to the Author by an Editor.

Applicant hereby amended “first graphical user interface screen” to “first blank story page screen” -- the limitation contained in previously presented (and hereby canceled) dependent claims 25, 30, and 35. Gonzales does not disclose any *blank story book screens*, but rather discloses a general web page publishing software. In Gonzales, what the user sees and inputs, is what the software outputs (i.e., WYSIWYG); therefore, Gonzales fails to disclose any use of blank story page screens in any respect, including as stated in independent claims 21, 26, and 31.

Third, in the Office Action, the Examiner stated Gonzales teaches “the first set of inputs comprising title information (Figure 6, Item 610), author information (Figure 6, Item 605)”. Office Action at p.3, para. 5. Gonzales paras. 0182-83 discloses: “1. A Name field 605 is for the article name or page name. 2. A Title field 610 is for the article title.” An “article name or page name” is not “*author information*”; an “article title” -- in the web page context -- is the <TITLE> tag in HTML, which relates to the title of the specific page (or “article”), not the title of the entire work. Accordingly, Gonzales does not disclose “the first set of inputs,” as stated in independent claims 21, 26, and 31.

Fourth, in the Office Action, the Examiner stated Gonzales teaches “wherein the cover page includes at least one of title information, author information, and one or more ... images (Para. 0181-193).” Office Action at p.3, para. 5. For at least the reason above that Gonzales does not disclose “title information” or “author information,” Gonzales does not

disclose “wherein the cover page includes at least one of *title information, author information*, and one or more images,” as stated in independent claims 21, 26, and 31.

Fifth, in the Office Action, the Examiner stated Gonzales teaches

“automatically generating, using said software program, a title page for printing on the first leaf’s back-side and a second leaf’s front-side, a first story page from the one or more ... images from the second set of inputs and a secondary story page from the second set of inputs including the one or more ... images and the corresponding text for printing on a third leaf’s front-side (Click a submit button to view the edited article. At this point the article is laid out in accordance with the template that the Author used to create the article, Para. 0209) for printing on the second leaf’s back-side”.

Office Action at p.3-4, para. 5. In aspects of the present disclosure, “the second set of inputs” effects automatic generation (i.e., in the step of “*automatically generating*”) of “a first story page, ... and a second story page”. In addition, the “first story page” is automatically generated “for printing on the second leaf’s back-side”; and the “second story page” is automatically generated “for printing on a third leaf’s front-side”. In Gonzales, no such step of automatic generation is disclosed, as what the user inputs/sees is what the software outputs (i.e., what the user gets). Therefore, Gonzales does not disclose the above mentioned steps of “*automatically generating*” as stated in independent claims 21, 26, and 31.

Sixth, in the Office Action, the Examiner stated that Gonzales teaches “wherein said one or more indicia include graphical symbols (image assets, Para. 0051; understood to be graphics)”. Office Action at p.8, para 11. Gonzales para. 0051 discloses

A content component of an article can be any of text, a link (text based or image based), or an asset (e.g., image, sound, video, animation). An element of a template is a defined space within which a content component is rendered, i.e., positioned and displayed, or in the case of an active content component such as an audio clip, executed. A template may include a plurality of elements.

Gonzales does not disclose using “*indicia*” “for indicating how to assemble ... in diametric contraposition,” as stated in independent claims 21, 26, 31. In addition, Gonzales does not

disclose “*automatically generating* one or more *indicia*” on pre-set pages for the above use (i.e., “indicating how to assemble ...in diametric contraposition”), as Gonzales is WYSIWYG publishing software. Although Gonzales discloses the general use of “an asset (e.g., image”) in creating web page content, it does not disclose using “graphical symbols” as “indicia” in the manner described above and as claimed. As a result, Gonzales does not disclose “said one or more indicia include graphical symbols,” as described in dependent claims 24, 29, and 34.

Seventh, in the Office Action, the Examiner stated that Gonzales teaches

wherein said first and second graphical user interface screens are blank story screens ([T]he publishing system is not limited to any particular number thereof. The web pages each include areas designated to contain substantive content, e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another page, Para. 0046, see also Figure 2).

Office Action at p.8, para 12. In aspects of the present disclosure, “blank story book screens” are depicted in Figures 1 through 4 (Figure 1 is an example of a first blank story screen, Figure 4 is an example of a second blank story book screen) and described at page 3, lines 13-14. Although Gonzales discloses general field-based inputs for webpage design, Gonzales does not disclose using “*blank story book screens*” with particular inputs for creating storytelling books for printing in diametric contraposition.

For all the reasons above, Applicant respectfully asserts that Gonzales does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

C. Scocca

First, in the Office Action, the Examiner stated Scocca teaches “wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page”. Office Action at p.4, para. 6. In particular, “instructional

indicia for indicating how to assemble the book (FIG. 1 is an illustration of the instruction sheet in which the contents of the invention the book publishing kit is listed”). Office Action at p.5, para. 6. “The templates taught by Gonzales would also be adapted to provide a page bearing publishing instructions, such as is taught by Scocca”. Office Action at p.5, para. 6. In addition, the Examiner stated Scocca teaches “instructional indicia for indicating how to assemble the book (2:13-31)”. Office Action at p.7, para. 9.

As shown in FIG. 1 of Scocca, Scocca discloses a separate instructional sheet. That is, Scocca does not teach or disclose “one or more *indicia* for indicating how to assemble the second story page” included in the “title page, and first and second story pages”. In other words, aspects of the present invention include printing “indicia” on the substantive title and story pages for showing the user how to assemble the story pages in *diametric contraposition*.

For all the reasons above, Applicant respectfully asserts that Scocca does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

D. Clements

First, in the Office Action, the Examiner stated that in Clements, the “page arrangement is understood to be ‘in diametric contraposition’.” Office Action at p.6, para. 7. As such, the Examiner contended that Clements teaches

automatically generating a second story page from the second set of inputs for printing on a third leaf’s front-side including the one or more images and the corresponding text, wherein the one or more images and corresponding text, when printed, appear oriented in diametric contraposition to the one or more images on the first story page,

as stated in independent claims 21, 26, and 31. However, Clements discloses WYSIWYG by providing insertion pages for the user to insert drawings or text (i.e., each insertion page requires

drawing(s) or text to be added). Accordingly, Clements does not teach “*automatically generating*” any story pages from inputs.

Second, in the Office Action, Examiner responds to “Applicant’s arguments further directed to Clements ‘172” as “not persuasive” because “[t]he courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” Office Action at p.10. para. 16. Applicant respectfully asserts that aspects of the present invention are not a mere automation of Clements. Aspects of Clements disclose using blank insertion pages and a WYSIWYG mode of operation, whereas aspects of the present invention, *inter alia*, allow the user to input data that then generates multiple pages from the input.

For the reasons above, Applicant respectfully asserts that Clements does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

E. Schubert

First, in the Office Action, the Examiner stated Schubert teaches “copyright information” by teaching “the front surface of the page is imprinted with general information about the use of the book, including a copyright notice (6:67-7:8).” Office Action at p.7, para. 8.

Schubert (7:2-7:4) discloses “[t]he front surface 28L of the page 34b is imprinted with general information about ordering the book, a copyright notice, etc.” However, in the context of Schubert, this “copyright notice” is for the owner of the copyright in the recordkeeping book (i.e., likely for the patent holder). In aspects of the present disclosure, the “copyright information” is for the *author* of the work (i.e., the *user* of the software; e.g., the student that authors a storytelling book of her own using the software).



For the reason above, Applicant respectfully asserts that Schubert does not teach or disclose the above mentioned limitations of at least currently amended independent claims 21, 26, and 31 and the claims that depend therefrom.

F. Schach

First, in the Office Action, the Examiner stated Schach teaches “a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover”. Office Action at p.9, para 14.

However, Schach does not teach or disclose “a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover, *wherein the second story page is oriented in diametric contraposition to the first story page*,” as stated in currently amended independent claim 31.

For the reason above, Applicant respectfully asserts that Schach does not teach or disclose the above mentioned limitations of at least currently amended independent claim 31 and the claims that depend therefrom.

G. Reasoning to Combine under KSR

As stated in MPEP § 2141:

The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made *explicit*. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness *cannot* be sustained by mere conclusory statements; instead, there must be some articulated *reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

(emphasis added).

Although Applicant respectfully asserts that the Examiner has not met his burden of identifying the claimed elements in the prior art (as traversed above), Applicant also submits that the Examiner has not provided adequate reasons to combine the cited references.

For combining Scocca to Gonzales, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include” various aspects of the present invention “in order to assist an amateur author in publishing a professional-looking story book” and “*to allow an amateur publisher to print and bind ‘proof’ or ‘draft’ copies of the storybook themselves, without requiring outside assistance or additional postage.*” Office Action at p. 6, para. 6 (emphasis added).

For combining Clements with Scocca and Gonzales, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by Gonzales to produce” various aspects of the present invention “as taught by Clements ‘172, in light of the teachings of Scocca, *in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume*”. Office Action at p.6-7, para. 7 (emphasis added).

For combining Schubert with Gonzales, Scocca, and Clements, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added” aspects of the present invention “to the title page template of Gonzales, as taught by Schubert, further in light of the teachings of Scocca and Clements ‘172, *in order to assist an amateur author in publishing a professional-looking storybook*”. Office Action at p.7, para. 8 (emphasis added).

For combining Schach with Gonzales, Scocca, Clements, and Schubert, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the kit to include aspects of the present invention “as taught by Schach, with a software program in a computer for publishing the book, as taught by Gonzales, in light of the teachings of Scocca, Clments ‘172, and Schubert, *in order to provide specialized, more durable paper to use for the cover of a story book*”. Office Action at p.9, para 14 (emphasis added).

Applicant respectfully asserts that Examiner has not provided any express reasons why one of ordinary skill in the art would have thought to combine the cited references. Rather, the Examiner has provided broad conclusory statements that merely say A covers X and B covers Y, so it would have been obvious to combine A and B because one would want to provide X and Y. For example, the Examiner states that combining certain cited references would be obvious to one of ordinary skill in the art “in order to assist an amateur author in publishing a professional-looking storybook”. Office Action at p.7, para. 8. However, the Examiner does not state *how* combination of four references would appear obvious to one of ordinary skill in the relevant art at the time of the invention to “assist an amateur author in publishing a professional-looking storybook”.

Moreover, there is no language or teachings within the cited references to give any reasons to one of ordinary skill in the art to combine those references. The solutions proposed and claimed as aspects herein, include steps for “*automatically generating*” certain pages (including pages which are not shown to the user until, for example, printing) from “*blank story book screens*” with certain information diametrically contrapositioned. In other words, the broad conclusory statements that the Examiner provides as purported reasons to combine the

references, do not give reasons for one of ordinary skill in the art to read the references (at the time the invention was made) and develop the Applicant's solutions to the problems in the prior art as claimed herein. As a result, Applicant respectfully asserts that Examiner's rejections under 35 U.S.C. § 103 are in error.

III. Request for Reconsideration

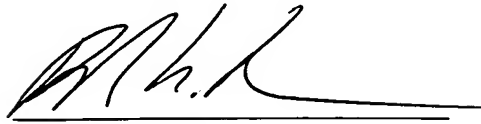
Applicant respectfully requests reconsideration of the present application in view of the aforementioned amendment and remarks. Although other features of the claims in the present application are also significant, Applicants respectfully submit that the pending claims are allowable for at least the aforementioned reasons. Accordingly, Applicant respectfully requests that the rejection under § 103 be withdrawn, and that the pending claims be allowed.

In the event that a telephone conference would advance examination of this application, the Examiner is invited to contact the undersigned at the number provided.

IV. Authorization

Applicant respectfully submits that no additional fee is due in connection with this paper. But in the event the Commissioner determines that an additional extension of time or fee is due for this paper, the undersigned hereby petitions for any required extension of time and authorizes the Commissioner to charge any fee required to Milbank's deposit account no. 13-3250, order no. 02013-06034. A DUPLICATE COPY OF THIS PAGE IS ENCLOSED HERewith.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. E. Reese', written over a horizontal line.

Blake E. Reese  
Reg. No.: 57,688

November 5, 2008

Milbank, Tweed, Hadley & McCloy LLP  
1 Chase Manhattan Plaza  
New York, NY 10005-1413  
(212) 530-5000 / (212) 530-5219 (facsimile)

NY2:#4810732